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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,060	08/02/2001	Marty Steinberg	99997.023404	6179
7590	10/02/2007		EXAMINER	
Nancy J. Flint Hunton & Williams 1111 Brickell Avenue Miami, FL 33131			CHAMPAGNE, DONALD	
		ART UNIT	PAPER NUMBER	
		3622		
		MAIL DATE	DELIVERY MODE	
		10/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/921,060	STEINBERG, MARTY
	Examiner	Art Unit
	Donald L. Champagne	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 August 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,5-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,5-18 and 21-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 August 2007 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1, 2, 5-18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US006061660A).
4. Eggleston et al. teaches (independent claims 1, 16, 22 and 23) a method and system for managing purchasing incentives offered to consumers through their existing memberships in loyalty programs, the method comprising:

receiving information regarding existing incentive/loyalty programs available to a consumer who revisits a host incentive program system (col. 15 line 60 to col. 16 line 13, col. 12 line 64 to col. 13 line 3 and col. 13 lines 20-21), which reads on receiving information regarding the consumer's existing memberships in one or more loyalty programs, the membership information comprising the name of the sponsor/offering company or organization for each loyalty program in which the consumer has membership (col. 16 lines 30-33 and col. 41 line 42);

storing the received membership information in a searchable database (*consumer database 200* and *sponsor database 202*, col. 12 lines 15-17);

thereafter receiving a query from one of the consumers comprising a request to identify purchasing incentives for a specific product or service (a *sponsoring company's products or services*) available through the one or more loyalty programs in which the consumer has membership (col. 12 lines 49-53, col. 16 lines 30-32, and col. 1 lines 30-36); and

processing the query to determine if any incentives are available for the specific product or service (col. 16 lines 33-41).

5. No patentable weight was given to the optional limitation,

"if any purchasing incentives are available, thereafter transmitting to the consumer information identifying purchasing incentives available through the one or more loyalty programs in which the consumer is a member for the specific product or service."

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04).

6. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
7. The instant application contains no such clear definition for the term "membership" or "member". In the instant case, the examiner is required to give the term "member" its broadest reasonable interpretation, which the examiner judges to be "one of the individuals composing a group" (Merriam-Webster's Collegiate® Dictionary, 10th ed.). In Eggleston et al., each incentive program registered by the sponsors (col. 12 line 67) in the *host incentive*

*program system* reads on a group in which the consumer is a member when the consumer registers with the *host incentive program system* (col. 12 lines 26-27).

8. Eggleston et al. does not teach that information regarding the consumer's existing memberships in one or more loyalty programs is received from a plurality of consumers. Because it would be advantageous to have as many participating offering companies/ sponsors as possible in the *sponsor database 202*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that consumers be invited to recommend sponsors to the *sponsor database 202*, which would read on receiving from a plurality of consumers information regarding the consumer's existing memberships in one or more loyalty programs.
9. The U.S. Supreme Court has recently ruled that it is obvious to combine prior art elements according to known methods to yield predictable results (*KSR INT'L CO. VS TELEFLEX INC.* 550 U.S. \_\_\_\_ (2007)). It is well known that consumers recommend loyalty programs to their friends. It would be obvious for those same consumers to recommend the loyalty programs for inclusion into a database of loyalty programs from which they themselves could benefit. The likely result would be greater consumer participation in the *host incentive program system*. Although this result is not certain, it is likely enough to justify a trial invitation to consumers for loyalty program sponsor recommendations. The Supreme Court also ruled in the *KSR* decision that it is obvious to try a new approach when there is a reasonable expectation of positive results.
10. Eggleston et al. also teaches at the citations given above claims 15 and 21.
11. Eggleston et al. also teaches: claims 2, 5, 6, 8, 17 and 18 (col. 14 lines 7-25, where for claims 5 and 18 querying *sponsor database 202* reads on transmitting the query to a plurality of offering companies and organizations); claims 9-11 (col. 18 lines 46-57); and claim 14 (col. 15 lines 8-12).
12. Eggleston et al. does not teach (claim 7) storing the query in a searchable database. Because the queries would be useful marketing information for the offering companies/ sponsors, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that the query be stored in searchable *consumer database 200*.

13. Eggleston et al. does not teach (claim 12) that at least some of the marketing information is transmitted anonymously. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to guard the privacy of consumers by anonymous dissemination of consumer data. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that at least some of the marketing information is transmitted anonymously.
14. Eggleston et al. does not teach (claim 13) offering compensation to the querying consumer if no incentive is available in response to the query. Because it would enhance customer service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that compensation be offered if no incentive is available in response to the query.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**16. ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



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Art Unit 3622

22 September 2007